REMARKS

An Office Action was mailed on December 23, 2003. Claim 1 is pending.

DRAWINGS

The Examiner objected to the drawings because FIG. 5 extends to a second drawing sheet that is not labeled. Responsive thereto, Applicant is filing herewith a new drawing sheet including FIG. 5 on a single sheet to overcome the Examiner's objection.

REJECTIONS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

Claim 1 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Responsive thereto, Applicant has amended the claim to overcome such rejections. Accordingly, it is respectfully requested that the Examiner withdraw the rejection under 35 U.S.C. § 112, second paragraph.

DOUBLE PATENTING

Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of co-pending application 09/736,874. Applicant traverses this rejection and the requirement to file a terminal disclaimer in view of the newly provided claims as discussed below.

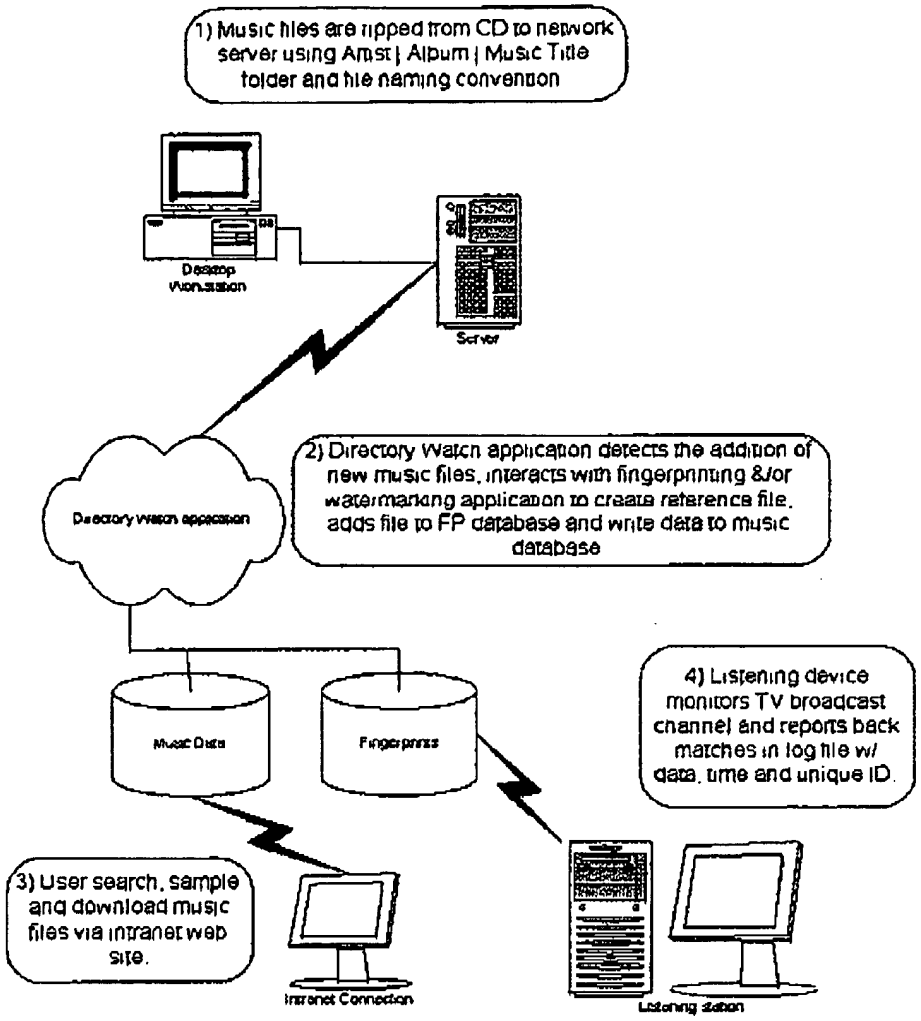
REJECTIONS UNDER 35 U.S.C. § 103

The Examiner notes that claims 1-3 and 5-11 are rejected under 35 U.S.C. §103(a) as being unpatentable over Ginter et al. (U.S. Patent 6,253,193) in view of Haggard et al. (U.S. Patent 6,148,335), even though the present application was originally filed with only one claim. While it is clear that the Examiner merely replicated the prior art rejections from co-pending application 09/736,874, Applicant will address such rejections as many of the claims from co-pending application 09/736,874 are newly introduced herein. Such prior art rejections are believed to be clearly overcome by the amendments presented herewith, as such amendments

narrow the scope of the present invention to a method for embedding an identification code into a digital audio recording file, and tracking, and cataloging the encoded audio recording's broadcasts and transmissions to ensure proper compensation due at least one performance artist responsible for generating content on said digital audio file. However, prior to addressing the Examiner's rejections, it is important to recount the crux of the present invention.

The present invention electronically monitors any audio broadcast, TV, Radio, Internet, or other, for pre encoded music with a unique watermark and/or unique digital fingerprint (*embedded identification code* in the claims) and electronically reports and aggregates these detections into an electronic music cue sheet report writer application for the purposes of reporting these electronic detected broadcast music performances to the appropriate Performing Rights Organizations (ASCAP, BMI, SESAC and others) for dsitrbuting Broadcast Royalty Distribution payments more accurately and efficiently. The method is effectively agnostic with respect to the identification technology used, and is mostly directed to a method for the electronic handling and aggregation of this detection data, including importing of associated performance data into a music cue sheet report writer application. The present invention, increases the accuracy, efficiency or electronic music cue sheet reporting as much as 70% when compared to the current manual reporting industry standard. The end result is for the Performing Rights Organization to receive an essentially automatically-generated show music cue sheet (industry standard), which until now has been a manual process riddled with inaccuracies and industry wide non compliance. The present invention has been up and working at NBC since 1999, and NBC has, during the use of the present invention, realized as much as a 70 % increase in music cue sheet reporting accuracy, efficiency and royalty revenue.

The following is illustrative of the present invention for public broadcast monitoring:



With this in mind, Applicant has amended the claims to be particularly representative of performance artist rights management as set forth in the originally-filed specification. The original claims were clearly construed by the Examiner in the broadest possible light, as none of the prior art references are directed to the monitoring and tracking of performance artist broadcasts for purposes of accurate and efficient compensation or royalty payments. For example, the Ginter et al. reference relates to a virtual distribution environment (VDE) having no relation to performance artists rights, while the Haggard et al. reference relates to a performance management framework for monitoring a computer network. However, neither of these primary and secondary references teach or reasonably suggest the management of performance artist's

rights through the cataloging of publicly transmitted audio and/or video broadcast performances. This is evident by the target passages in the prior art references asserted by the Examiner and that mention certain words used in the originally filed claims (see column 6, lines 40-55 of Haggard et al. labeled by the Examiner as "performance transmission and broadcast data", such labeling located in the Examiner's marked-up reference sent with the Detailed Action).

To clearly overcome the Examiner's prior art rejections, the present invention is now claimed as a method for embedding an identification code into a digital audio recording file, and tracking, and cataloging the encoded audio recording's broadcasts and transmissions to ensure proper compensation due at least one performance artist responsible for generating content on said digital audio file, said method comprising the steps of embedding an identification code within a digital audio recording file; transferring said encoded digital audio recording file onto a digital signal compatible medium; transmitting said encoded digital audio recording file as an encoded audio signal, wherein the transmitting is from a radio or television station broadcast, including cable and satellite networks and internet websites; receiving said encoded audio signal by a suitable digital signal detecting device; feeding the received and encoded audio signal into a cross phasing means that increases the accuracy of an encoded signal monitoring means, feeding the cross-phased received and encoded audio signal into said monitoring means, which monitoring means recognizes the identification code, and, based on said identification code records and stores the identification code and transmission and broadcast related data as a batch file, said broadcast related data including a date that the encoded audio signal was monitored, a time of day that the encoded audio signal was monitored, and the duration of the monitored encoded audio signal; decoding and importing the batch file into a first database that catalogs performance, transmission and broadcast of the encoded audio signal, and using said first database to accurately compensate the at least one performance artist responsible for generating content on said digital audio recording file. Such claim is clearly supported in the original specification, which is clearly directed to the efficient and accurate management of performance artist transmissions and associated royalties. Newly provided claims 2-8 were imported from the Applicant's co-pending and parent application 09/736,874. Newly provided claims 9 - 11 are

respectively derived from claims 1, 5, 6 and 8, with emphasis on the essential features of claims 1, 5, 6 and 8.

Applicant respectfully submits that the prior art of record fails to teach or reasonably suggest the totality of the claimed invention as specifically set forth in the pending claims, and Applicant believes the claims are allowable over the cited art for the reasons set forth above. Applicant also respectfully submits that a prima facie case of obviousness has not been successfully established. Applicant notes that, particularly in connection with the Detailed Action from the parent '874 application, the Examiner liberally asserts the concept of Official Notice and liberally interprets the teachings of the Ginter and Haggard references in an analogous manner to the method of the claimed invention. However, in view of the narrowing amendments submitted herewith, Applicant respectfully submits that one skilled in the art could not reasonably interpret the asserted passages of Ginter and Haggard as teaching or reasonably suggesting, in combination, the invention as now particularly claimed, without the application of improper hindsight.

As the CAFC stresses for a § 103 rejection to stand, the Examiner is required to show **with evidence** the motivation, suggestion or teaching of the desirability of making the specific combination at issue. That evidence is required to counter the powerful attraction of a hindsight-based obviousness analysis. See, for example, *In re Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q. 2d 1430, 1433 (Fed. Cir. 2002) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references"). It is respectfully submitted that this involves more than a mere bald assertion that it would be obvious to combine the cited references. With respect to the Ginter and Haggard references, the Examiner has a duty to explain with specificity how one skilled in the art would combine the teachings of such references, each of which have nothing to do with the compensation of performance artists for publicly transmitted and broadcast audio files, to arrive at a management scheme directed specifically to claimed system of accurately and efficiently cataloging and tracking content generated by performance artists for purposes of ensure appropriate compensation for the same. *In re Lee* requires that the record must state with particularity all the

evidence and rationale on which the PTO relies for a rejection and sets out that it is necessary to explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.

As noted above, Applicant submits that there is no suggestion of the desirability to combine the Ginter and Haggard references, nor is there any motivation demonstrated in either of the references to combine them, nor is there any suggestion in either reference to adapt their systems to the unique system as specifically set forth in the amended claims of the present invention. The only way to arrive at the specifically claimed present invention from the Ginter and Haggard references is through the application of improper hindsight, as neither reference teaches or reasonably suggests anything having to do with the general concepts behind the present invention. For the foregoing reasons, reconsideration is respectfully requested.

An earnest effort has been made to be fully responsive to the Examiner's objections. In view of the above amendments and remarks, it is believed that claims 1-11, consisting of independent claims 1 and 9 and the claims dependent therefrom, are in condition for allowance. Passage of this case to allowance is earnestly solicited. However, if for any reason the Examiner should consider this application not to be in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

Any fee due with this paper may be charged on Deposit Account 50-1290.

Respectfully submitted,

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